

In re Application of: Florian, J.
Serial Number: 10/780,813

Remarks and Comment

Examiner rejects all pending claims on *NEW* grounds of rejections without *proper basis*. These rejections based upon new art were brought at this late stage of prosecution not as a result of any Applicant amendment which might provide proper basis for new rejections, but rather, as a result of Examiner's whim and without any explanation whatever for taking this action out of order. Applicant takes exception and hereby requests reconsideration.

Despite the new rejections being improperly placed, Applicant does now provide this response to them while reserving the right to argue the rejections are improper. That a response is made is not acknowledgement the rejections are valid, but rather is done so in the interest of expeditiously arriving at an early grant date should Examiner sufficiently defend a position in support of bringing these new rejections at a late hour.

REJECTIONS UNDER 35 U.S.C. §103

1) Examiner fails to make a prima facie case of obviousness.

Examiner has not demonstrated all elements of a prima facie case, and therefore Examiner's showing of obviousness is deficient and Applicant is deserving of a patent. The Federal Circuit endorses this view in writing:

"if the examination at the initial stage does not produce a prima facie case of unpatentability, then without more the applicant is entitled to grant of the patent."¹

To successfully establish a prima facie case of obviousness, Examiner must provide: 1) one or more references, 2) that were available to the inventor(s), 3) and that teach, 4) that include a cooperation of the references, 5) the combination or modification of which would appear to be sufficient to have made the claimed invention obvious to one of ordinary skill in the art. Failure on either of these 5 points, is a failure to establish the required prima facie case of obviousness. In the case at bar, Examiner has failed to establish one or more of these elements which necessarily renders the position for 'obviousness' developed by Examiner defective or at least incomplete.

¹ *In re Oetiker*, 977 F.2d 1443, 24 U.S.P.Q. 2d 1443 (Fed. Cir. 1992)
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More importantly in the present case, Examiner does not rely upon well developed evidence established in accordance with the above guidelines, but rather forms obviousness rejections on mere *conclusionary statements*.

5 **"Rejections on obviousness cannot be sustained by mere conclusory statements."**²

In the present case, Examiner writes at paragraph 3: "which would be capable of redirecting light beams" – of Bryars' optical filter. Optical filters are not typically used this way and are not used by Bryars to redirect optical beams.
10 If Examiner wishes to find Applicant's waveguide in Bryars' more will have to be developed on this point as the filter alone cannot be considered equal to Applicants very sophisticated waveguides.

In another instance, Examiner writes:

15 "Furthermore, it would have been obvious to one of ordinary skill in the art that since the device emits light, receives light, detects and processes the received light signal, the device has entrance and exit apertures capable of performing the desired function".

and,

20 "Bryars et al. do not explicitly teach the dimensions of the apertures. However, it would have been obvious to one of ordinary skill in the art that the dimensions of the apertures may be altered or modified as desired by the user and it would be obvious to one of ordinary skill in the art that the device of Bryars et al. is capable of performing the function required by an entrance and exit aperture and is therefore a functional equivalent."

25 Examiner concludes '*it would have been obvious*' but fails to provides an obvious analysis on the point. Rather, Examiner merely declares it so without showing whatever to that effect. Examiner will have us believe that because 'it emits, receives, and processes light – it must have apertures capable of performing desired function. However, this conclusion is wholly incorrect and not well

² In re Kahn, 441 F.3d 977, 988 (CAFC 2006).

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placed. It most certainly is not sufficient finding for attributing Applicant's claimed apertures into Bryars' teaching.

Examiner then further declares that it would be obvious that the dimensions be altered '*by the user*'. But neither Bryars nor Applicant has any provision whatever with regard to a user altering the apertures. It is unknown what Examiner means that a user might alter an aperture.

Further, Examiner suggests it is obvious that it is "capable of performing the function..." But whether or not something is obvious that it might perform any particular function has no bearing on an obviousness analysis with regard to a claim element missing in the art. Accordingly, the 'obviousness' rejection is not well formed. Reconsideration and redirection is requested. Please clarify which claim element is being 'found' in Bryars as 'obvious'.

These conclusionary statements without foundation cannot be basis for any legal holding of obviousness under 35 USC 103.

The five necessary prima facie obviousness points are addressed herefollowing with specificity and with further reference to the text of the office action.

A) References are Required to 'Teach'

I) References Do Not Contain Required *Teachings*

The Federal Circuit has made it quite clear in saying:

"[t]he test for obviousness is not whether the features of one reference may be bodily incorporated into another reference...Rather, we look to see whether combined teachings render the claimed subject matter obvious."³

Although Examiner purports to find each element in a complex and compound combination of Bryars-Goodman-Cerwin, Examiner does not show how those references actually *teach* the combination as required.

³ *In re Wood*, 599 F.2d 1032, 202 U.S.P.Q. 171, 174 (C.C.P.A. 1979) (citing *In re Bozek*, 416 F.2d 1385, 1390, 163 U.S.P.Q. 545, 549-50 (C.C.P.A. 1969); *In re Mapelsden*, 329 F.2d 321, 322, 141 U.S.P.Q. 30, 32 (C.C.P.A. 1964))

II) Cited Teachings are Not *Enabling*

The obviousness standard requires prior art to teach. Accordingly, nonenabling inventions, for example failed experiments or inoperative inventions, are not to be considered prior art⁴. Courts have held that failed experiments are irrelevant as prior art and cannot be used in an obviousness rejection⁵. The Federal Circuit notes in writing:

"The 'failed' experiment reported in the prosecution history of the Mason patent renders that patent irrelevant as a prior art reference. As stated by Judge Learned Hand, 'another's experiment, imperfect and never perfected will not serve as an anticipation or as part of the prior art, for it has not served to enrich it.'⁶"

As Bryars, Goodman, and Cerwin amount to little more than proposed possibilities and do not correspond to actual functional designs having any operational history, these should be excluded from the body that is prior art.

B) **Justification for Combination or Modification of the References**

I) Cited references must include some cooperation; in example, a teaching, suggestion or motivation, or other reason why they would have been combined or modified in a manner to bring about Applicant's claimed invention.

While the Supreme Court decision in KSR v. Teleflex did significantly modify the so called "*teaching, suggestion, motivation*" test, it has not entirely eliminated the necessity that there be certain cooperation between art references cited by Examiner. It is surely not enough that Examiner find some of Applicant's claim elements in a first reference, and some elements in another, and thereafter merely declare: "it would have been obvious...". We can be certain of this, as *all inventions* are comprised of known elements and components readily found in the art.

⁴ In re Wilder, 429 F.2d 447, 166 U.S.P.Q. 545, 548 (C.C.P.A. 1970)

⁵ Fromson v. Advance Offset Plate, Inc., 755 F.2d 1549, 225 U.S.P.Q. 26, 33 (Fed. Cir 1985)

⁶ Picard v. United Aircraft Corp., 128 F.2d 632, 635, 53 U.S.P.Q. 563, 566 (2d Cir.) *cert. denied*, 317 U.S. 651 (1942)

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Even prior to performing an ‘appearance of obvious’ test under *Graham v. Deere*, Examiner must first settle the issue of why the references should be combined/modified. KSR-Teleflex does not relieve Examiner of performing this step. If Examiner remains silent or does not provide sufficient showing on this point, the *prima facie* case is not made and the obviousness rejection must be withdrawn. Despite KSR-Teleflex, “it remains necessary to identify the reason why a person of ordinary skill would have combined the prior art elements in the manner claimed”⁷. In the present case, Examiner has not described what cooperation exists if any and has not described why a person would have combined the prior art elements in the manner claimed.

Only the rigidity of the *TSM* test has been shaken by the KSR-Teleflex decision – *it has not been eliminated*. “[TSM] gives us forceful instruction on the manner in which the test is to be applied”⁸.

There must be some logical reason apparent from *positive concrete evidence* of record that justifies a combination of primary and secondary references⁹. It is insufficient to show merely that each separate element of a claimed combination can be found in one or various prior art references¹⁰. The mere fact that it is possible to find two isolated disclosures which might be combined in such a way to produce a new compound does not necessarily render such production obvious unless the art also contains something to suggest the desirability of the proposed combination¹¹. Combining the teachings of the prior art to produce the claimed invention, absent some showing of cooperation, incentive,

⁷ USPTO memo from Deputy Commissioner of Operations to technology art unit directors May 23, 2007, in view of KSR Teleflex decision.

⁸ *Leapfrog v. Fisher-Price & Mattel*, CAFC 06-1402

⁹ *In re Regel*, 526 F.2d 1399, 1403, 188 U.S.P.Q. 136, 139 (C.C.P.A. 1975); *In re Stemniski*, 444 F.2d 581, 586-587, 170 U.S.P.Q. 343, 348 (C.C.P.A. 1971).

¹⁰ *Canadian Ingersoll-Rand Co. v. Peterson Prod., Inc.*, 223 F.Supp. 803, 139 U.S.P.Q. 61 (N.D. Cal 1963)

¹¹ *In re Gergen*, 11 U.S.P.Q. 2d 1652, 1653 (C.A.F.C. 1989); *In re Grabiak*, 769 F.2d 729, 732, 226 U.S.P.Q. 870 872 (C.A.F.C. 1985).

teaching, suggestion, motivation supporting the combination cannot establish obviousness.

Examiner does not show any indication from either Bryars, Goodman or Cerwin with regard to combining the resources. Examiner has failed entirely to present any reason or suggestion that one would be motivated to merge the references. But rather, in striking contrast to accepted procedure, Examiner relies upon the references solely for their mention of one or more of Applicant's claim elements.

II) References Teach Away

The position for a finding of a lack of motivation to combine or modify is further supported by the prior art which teaches away from Applicant's claimed inventions. A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that the applicant took¹². Further, a reference teaches away if it suggests the line of development flowing from the reference's disclosure is unlikely to be productive of the result sought by Applicant[s]¹³.

References cited teach away from Applicant's claims as follows. In each of the cited references, light gathering is assumed to be readily made and there is no provision for improving the light gathering via waveguide concentration of light. Thus, the references teach away by suggestion signal to noise ratio may be sufficient without improvements to the optical geometries. Accordingly, practitioners would be inclined to

¹² *In re Gurley*, 27 F.3d 551, 31 U.S.P.Q. 2d 1130, 1131 (Fed. Cir. 1994)

¹³ *United States v. Adams*, 383 U.S. 39, 52, 148 U.S.P.Q. 479, 484 (1966) ("known disadvantages in old devices which would naturally discourage the search for new inventions may be taken into account in determining obviousness"); *W.L. Gore & Assocs. v. Garlock, Inc.*, 721 F.2d 1540, 1550-51, 220 U.S.P.Q. 303, 311 (Fed. Cir. 1983) (the totality of a reference's teachings must be considered), *cert. denied*, 469 U.S. 851 (1984); *In re Sponnoble*, 405 F.2d 578, 587, 160 U.S.P.Q. 237, 244 (C.C.P.A. 1963) (reference teaches away if it leaves the impression that the product would not have the property sought by the applicant)

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improve the electronics before attempting to manipulate the optical signal captured by the device.

III) Combination Includes Application of Hindsight

Not only must a suggestion or motivation to form the combination exist, but it must have existed before the date of Applicant's invention¹⁴.

Thus it is incorrect for Examiner to formulate the suggestion or motivation based on current knowledge; Examiner must remove all knowledge accumulated since the date of invention¹⁵. As stated by the Federal

Circuit:

"It is impermissible to use the claimed invention as an instruction manual or 'template' to piece together the teachings of the prior art so that the claimed invention is rendered obvious. This court has previously stated that '[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.'"¹⁶

It is well settled that Examiner must refrain from use of hindsight when examining the question of obviousness¹⁷. The invention must be viewed not with the blueprint drawn by the inventor, but in the state of the art that existed at the time the invention was made¹⁸. To use the application in suit as a guide through the prior art references, combining the right references in the right way to arrive at the result of the claims, is, therefore, quite improper.

The record compels the conclusion that the Examiner, having carefully considered Applicant's disclosure at length was unable to cast the mind back to the "time the invention was made". Examiner did not, as the

¹⁴ 35 USC §103 ("...the subject matter as a whole would have been obvious at the time the invention was made")

¹⁵ *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561, 1 U.S.P.Q. 2d 1593, 1595-96 (Fed. Cir.) *cert. denied*, 481 U.S. 1052 (1987)

¹⁶ *In re Fritch*, 972 F.2d 1260, 23 U.S.P.Q. 2d 1780, 1784 (Fed. Cir. 1992) (quoting *In re Fine*, 837 F.2d 1071, 1075, 5 U.S.P.Q. 2d 1596, 1600 (Fed. Cir. 1988))

¹⁷ *AIR-vend, Inc. v. Thorne Indus., Inc.*, 625 F.Supp. 1123, 1136, 229 U.S.P.Q. 505, 515 (D. Minn. 1985)

¹⁸ *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1138, 227 U.S.P.Q. 543, 547-548 (C.A.F.C. 1985)

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statute requires, view the prior art from the perspective of one skilled in the art and uninformed by Applicant's teachings. Applicant described in detail shortcomings of prior art and the superiority of the present invention in accord with the claims. In deciding the obviousness question, Examiner
5 looked to knowledge taught by Applicant, and then used that knowledge against its teacher.

The test is whether the subject matter of the claimed inventions would have been obvious to one skilled in the art at the time the inventions were made, not what would have been obvious to a trier of fact after
10 reading the application in suit. In the present case, for example, one skilled in the art on 2/17/2004 would not find in the prior art neither a teaching nor suggestion of the claimed inventions.

C) Combination or Modification Must *Appear* to be Obvious.

15 Applicant rejects suggestions prima facie elements are made, i.e. that references: are available; teach; or contain suggestions to combine. However, the following presentation argues against any of Applicant's claims as being obvious. Although presentation of such argument may appear to endorse the position that cited references are valid, Applicant explicitly rejects such conclusion and hereby
20 states the contrary to be the case.

A standard of obviousness is set forth in **Graham v. John Deere Co**¹⁹. It is a three part test where: 1) the scope and content of the prior art is to be determined; 2) the differences between prior art and Applicant's claims are to be ascertained; and 3) the level of ordinary skill is to be resolved. Against this
25 background, obviousness or nonobviousness of the subject matter is to be determined.

That test has not been properly applied by Examiner. Applicant is faced with Examiner's mere assertion "*it would be obvious*". Examiner's Action lacks

¹⁹ 383 U.S. 1, 15, 148 U.S.P.Q. 459, 466 (1966)
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full analysis of: scope and content of the art; difference or differences; or level of ordinary skill. Applicants solicit reconsideration and redirection with respect to these rejections having been made without proper basis. Applicant further requests detailed explanation so that an appropriate response and defense can be formulated.

That an applicant is entitled a patent is established by the introductory language of 35 U.S.C. §102²⁰. While 35 U.S.C. §103 imposes further condition for patentability beyond novelty, such does not have the effect of placing the burden of proving the irrelevancy of prior art upon Applicant²¹. Rather, it is to the Examiner to provide at least an appearance of obviousness; failing that, the rejection must be withdrawn.

In the present case, Examiner has not put forth the required appearance of obviousness but rather has merely asserted such without foundation, explanation or backing of any sort. The rejections should therefore be withdrawn. This is not the first time, but rather the *second* that Examiner has brought a defective case of obviousness, the first having been withdrawn without reason or explanation, that being enough for Applicant to claim right to patent grant, but Examiner did not grant the application as required by code but rather took a step out of order and formulated additional rejections without proper basis for forming new rejections, further those rejections being insufficient to support the required prima facie case of obviousness. Accordingly, immediate withdrawal is warranted.

Applicant now presents facts in support of a finding of *non-obviousness* for Examiner to consider in further review; all the evidence must now be considered anew²².

2) Rebuttal to Examiner's Case of Obviousness

²⁰ 35 U.S.C. 102: 'A person shall be *entitled* to a patent unless-. [emphasis added].

²¹ Color Communications, Inc. v. La Clede Mfg. Co., 7 U.S.P.Q. 1164, 1166-67 (W.D.N.Y. 1987).

²² *In re Eli Lilly & Co.*, 902 F.2d 943, 14 U.S.P.Q.2d 1741, 1743 (C.A.F.C. 1990); *In re Piasecki*, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (C.A.F.C. 1984); *In re Rinehart*, 531 F.2d 1048, 1052, 189 U.S.P.Q. 143, 147 (C.C.P.A. 1976)

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Although Applicant wholly rejects any notion that a prima facie case is made, if after appropriate and full review by Examiner or a Board of Appeals that position is affirmed, then Applicant provides following argument in rebuttal to such prima facie case.

5 A) **Technical differences**

Technical differences between Applicant's claimed invention and cited art, including combinations thereof, were not considered by Examiner remain without address. It is not sufficient for Examiner to examine a few, or selected, or primary differences in view of tests for obviousness, but rather, Examiner must
10 examine all differences. The following technical differences were not addressed in Examiner's Office Action. Reconsideration is requested.

i) Applicant claims a 'disk' shaped optical coupling. A disk having radial symmetry is shown in the disclosure to have considerable light concentration properties. Nothing in the art relates to such mechanical advantage
15 and Examiner does not provide support in any claim rejection discussion for disk shaped waveguides.

ii) Applicant explicitly claims a 'waveguide' array. Examiner does not find, nor allege to find, any waveguide array in either of the three references. While one of the references does mention a single waveguide, there is no
20 indication this element has any relationship to any other element in a manner compatible with the claimed invention – a necessary consideration. Not only is Examiner required to find the equivalent elements in the art, but those elements must be related to cooperating elements in the same way as claimed by Applicant. There is no showing of a waveguide array or any relationship with cooperating
25 elements. Rather, Examiner merely mentions what a waveguide may be used for in a general sense; and even this presentation is incorrect as a waveguide of these systems is never used for manipulating the angle of incidence.

iii) The 'entrance aperture comprises a planar annular region' this explicitly claimed element has been ignored by Examiner and is entirely left
30 without address nor mention in the office action. This important difference lies at

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the heart of the invention and should be considered with great care. Rather, Examiner merely omits any consideration of this important element.

iv) particulars regarding the beam turning element are not found in the art and Examiner has not asserted these explicitly claimed features are found there. In particular, 'arranged to redirect beams incident... ..in a radially inward direction' No beam turning element of the art has this arrangement and Examiner does not present any evidence of such. It is necessary that all elements be considered in their full definition as provided by the claims. That Examiner can find some beam turning element in some reference is not enough to obviate entirely the beam turning element as claimed by Applicant.

v) 'a waveguide is comprised of a plurality of 'pie-wedge' shaped elements'. This feature is explicitly claimed. It is not enough that Examiner can find somewhere in the 7 million US patents that someone has made a pie-wedge waveguide – Applicant does not claim to be the inventor of pie-wedge waveguides – rather a waveguide array of pie-wedge elements forms the particular collector as taught exclusively by inventor without and to the exclusion of those teachings of the art.

These and many other elements explicitly claimed by Applicants are entirely left without proper address by Examiner. Examiner is required to consider each and every difference of each and every claim. Examiner reference to Cerwin's waveguide is vague, slight, general and obscure. It is not an obviousness analysis by any measure of principles set forth in *Graham v. Deere*.

3) **Examiner has improperly abandon without cause a previous prosecution**

If Examiner fails to point to any amendments made by Applicant which necessitates new rejections based upon newly introduced art – new rejections are improper. As such, Examiner abandons without cause a previously established

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position not supported by the necessary prima facie obviousness showing. Courts have been clear on this point:

"if the examination at the initial stage does not produce a prima facie case of unpatentability, then *without more* the applicant is entitled to grant of the patent."²³ (emphasis added)

To initiate another examination at this late stage, based upon new art and new rejections amounts to a form of 'double jeopardy' where the question of patentability was first tried and failed, and then subject to a second independent trial. If such were allowable procedure, then nothing would prevent an examiner from re-testing repeatedly the case against patentability based upon a third, or fourth, et seq, set of prior art without end.

4) **Examiner's Rejection(s) are Procedurally Defective**

Examiner has not provided necessary information required by MPEP §706.02(j). Examiner's burden for supporting an obviousness rejection is described as follows:

"35 USC §103 authorizes a rejection where to meet the claim, it is necessary to modify a single reference or to combine it with one or more others. After indicating that the rejection is under 35 USC §103, there should be set forth in the office action (1) the relevant teachings of the prior art relied upon, ... (2) the difference or differences in the claim over applied reference(s), (3) the proposed modification of the applied reference(s) necessary to arrive at the claimed subject matter, and (4) an explanation why such proposed modification would have been obvious to one of ordinary skill in the art at the time the invention was made."

Applicant hereby requests Examiner provide information required in agreement with MPEP and further specify information necessary to support an obviousness type rejection. Reconsideration of the rejection is requested in view of 37 CFR 1.111(b).

5) **Examiner Uses Personal Knowledge**

²³ *In re Oetiker*, 977 F.2d 1443, 24 U.S.P.Q. 2d 1443 (Fed. Cir. 1992)
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5 It appears, at least in part, that Examiner uses personal knowledge or
judicial notice to support rejections relating to obviousness. Accordingly,
Applicant hereby requests an affidavit under 37 CFR §1.107(b) with respect to
any and each rejection based upon Examiner's personal knowledge or judicial
notice.

10 As this answer traverses each and every rejection set forth in the above-identified
examination, the claims are now in condition for immediate allowance. In accordance,
Applicant now supplicates re-examination and a favorable conclusion on the earliest
possible occasion should it please his Honorable Commissioner.

Very respectfully submitted,



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reg. # 35,311